IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Katherine Woo   Examiner: Mark Fadok

Serial No.:   10/791,156   Group Art Unit: 3625

Filed: March 1, 2004   Docket: 2043.011US1

Title: INTEGRATING THIRD PARTY SHOPPING CART APPLICATIONS WITH
              AN ONLINE PAYMENT SERVICE

PRE-APPEAL BRIEF REQUEST FOR REVIEW

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Applicant requests review of the final rejection mailed January 8, 2007 and the Advisory

Action mailed March 21, 2007 in the above-identified application. No amendments are being

filed with this request. This request is being filed with a Notice of Appeal. The review is

requested for the reasons stated below:

§102 Rejection of the Claims

In the Final Office Action of January 8, 2007, claims 1-24 were rejected under 35 U.S.C.

§ 102(b) as anticipated by Sacks (U.S. Publication No. 2002/0016765 A1). Applicant

respectfully traverses the grounds for rejection for the reasons argued below.

Applicant respectfully submits that the Final Office Action did not make out a *prima*

facie case of anticipation because Sacks does not disclose each and every element of Applicant's

claims, arranged as in the claims.

Claim 1 recites, with emphasis added:

1. A computer-implemented method comprising:
       receiving, from a shopping cart application, detailed information
concerning one or more items placed by a user in **a virtual shopping cart hosted**
by a merchant web site, the shopping cart application being external to an
online payment service, the detailed information being sent by the shopping cart
application in response to a user request to proceed with a payment for the one or
more items; and
       upon receiving the detailed information from the shopping cart
application, communicating to the user via a communications network one or
more user interfaces that facilitate processing of the payment for the one or more
items, the one or more user interfaces allowing the user to view content of the
virtual shopping cart.

Sacks does not disclose either of the limitations, "**the shopping cart application being external to an online payment service**" and "**a virtual shopping cart hosted by a merchant web site,**" as recited in claim 1 of the present application.

Referring to Office Actions mailed in 11/30/2005 (page 4, para 1) and 06/13/2006 (page 4, para 2), both of the Office Actions acknowledge that in Sacks, "**it is not fully clear that shopping cart application is external to the payment processor, per se.**"

The Final Office Action of January 8, 2007 restates the Office Action mailed 6/3/2005, and disagrees with Applicant's argument provided 9/8/2005 that Sacks does not disclose the limitation "**the shopping cart application being external to an online payment service.**" Regarding this point, the Final Office Action states, on page 4, (with emphasis added):

> Applicant argues that Sackes does not teach a shopping cart being external to the payment processor. The examiner disagrees and directs the applicants attention to **para 0016-0023**, where the buyer is redirected or transferred to a third party processor. Since the third party payment processor receives a connection from the buyer after the buyer and seller have concluded a transaction and the transaction information is provided through the buyer connection, it is clear that **the third party payment processor is external to the payment processor**.

Applicant disagrees with the above quoted assertion of the Final Office Action of January 8, 2007 that Sacks discloses, "**the third party payment processor is external to the payment processor.**" Referring to para 0016 lines 8-12, Sacks discloses, (with emphasis added):

> **The third-party payment processor ("payment processor")** receives a connection from the buyer and processes the buyer's payment using information provided by the user and/or details of the present transaction received with the buyer's connection.

Thus, it is clear that, in Sacks, **the third party payment processor is referred to as the payment processor, i.e., the third party payment processor is the payment processor, and vice versa.** For that reason, Sacks does not indicate, "**the third party payment processor is external to the payment processor**" as asserted in the Final Office Action.

Furthermore, in fact, the term "**shopping cart**" does not appear in para 0016-0023 relied upon in the Final Office Action. Instead, reference is made to "shopping cart", e.g., in specification para 0028, 0032, 0034 and 0036, and in claims 16, 17 and 31 of Sacks, which are

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reproduced below:

> "In another embodiment, **payment processor 106 may provide a third-party shopping cart to track the buyer's purchases**. Thus, in this embodiment, when a buyer's connection is redirected, the buyer may be presented with a shopping cart managed by the payment processor." (para 0028 of Sacks)

> "FIG. 2 is a block diagram of a third-party payment processor according to one embodiment of the invention. In this embodiment, **payment processor 200 comprises** communication interface 202, seller interface 204, **buyer interface 206**, registration module 208, **database 210** and payment processing module 212." (para 0030 of Sacks)

> "**Buyer interface 206 is configured to** elicit necessary information from a buyer to create a new account, retrieve an existing account, identify a desired payment mechanism (e.g., credit card, debit card, bank account), **access or update a shopping cart**, etc." (para 0032 of Sacks)

> "**Database 210 stores** various user information concerning buyers and sellers, such as account information, **buyer shopping carts**, HTML code for sellers, etc." (para 0034 of Sacks)

> "In state 300, **a third-party payment processor assists a seller in** configuring a link, using HTML or other similar coding, for a buyer to select when he or she wishes to complete a transaction (i.e., initiate payment) or **access a third-party shopping cart** (e.g., to add or remove an item)." (para 0036 of Sacks)

> "16. The method of claim 1, further comprising **maintaining a shopping cart at the third party for the payor.**"

> "17. The method of claim 16, wherein **said shopping cart is configured to track the payor's transactions with multiple payees.**"

> "31. **The payment processor** of claim 29, further comprising **a database configured to store a shopping cart for the payor.**"

Thus, Sacks fails to disclose each and every element of the claimed invention as arranged as in claim 1 because **the shopping cart of Sacks is a third-party shopping cart and is internal to the third party payment processor**, which is in contrast to the feature of claim 1 that recites, "**the shopping cart application being external to an online payment service.**"

Additionally, Sacks fails to disclose "**a virtual shopping cart hosted by a merchant web site**," as recited in claim 1 of the present application, because the shopping cart of Sacks is a

third-party shopping cart and is internal to the third party payment processor rather than being hosted by a seller (merchant) web site.

The Advisory Action challenges Applicant's argument, "Sacks does not disclose 'a **virtual shopping cart hosted by a merchant web site,**' as recited in claim 1 of the present application". However, the Advisory Action fails to point out which part of Sacks is intended to disclose this element of claim 1. The Advisory Action indicates "... in order for the information to be collected at the merchant and later transferred to the payment processor, an application must be present on the merchant server to perform the processing." Applicant traverses this assertion and submits that such a conclusion is a hindsight interpretation of Sacks.

Therefore, Applicant respectfully submits that Sacks fails to disclose each and every element of claim 1 of the present application. Thus the anticipation rejection of claim 1 as anticipated by Sacks is improper as failing to make out a prima facie showing of anticipation.

Independent claims 10 and 18 each recite "**the shopping cart application being external to an online payment service**" and "**a virtual shopping cart hosted by a merchant web site.**" For at least the same reasons discussed with respect to claim 1, Applicant respectfully submits that the anticipation rejection of claims 10 and 18 as anticipated by Sacks is improper as failing to make out a prima facie showing of anticipation.

Independent claim 22 recites, "**a virtual shopping cart hosted by a merchant web site**" which, as discussed above, is not disclosed in Sacks. Thus, Applicant submits that the anticipation rejection of claim 22 as anticipated by Sacks is improper as failing to make out a prima facie showing of anticipation.

Claims 2-9, 11-17, 19-21, and 23-24 each depend, directly or indirectly, on one of claims 1, 10, 18, or 22. For at least the reasons discussed above for the independent claims 1, 10, 18, and 22, Applicant submits that the anticipation rejection of claims 2-9, 11-17, 19-21, and 23-24 as anticipated by Sacks is improper as failing to make out a prima facie showing of anticipation.

Therefore, Applicant respectfully requests the withdrawal and reconsideration of the rejection of claims 1-24.

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CONCLUSION

Applicant respectfully submits that all of the pending claims are in condition for allowance, and such action is earnestly solicited. The Examiner is invited to telephone the below-signed representative at 612-373-6900 to discuss any questions which may remain with respect to the present application.
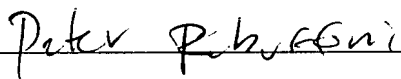
If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,
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By his Representatives,

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Date ___4/9/2007___   By _____
Jun Wei
Reg. No. 55,717

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this _9_ day of April 2007.

_____   _____
Name   Signature